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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/517,244	12/07/2004	Hiroiyuki Morioka	112857-402	3110
29175	7590	04/03/2006	EXAMINER	
BELL, BOYD & LLOYD, LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			COOKE, COLLEEN P	
			ART UNIT	PAPER NUMBER
			1754	

DATE MAILED: 04/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/517,244

Applicant(s)

MORIOKA ET AL.

Examiner

Colleen P. Cooke

Art Unit

1754

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 27 and 28.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.


Colleen P. Cooke
Primary Examiner
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Advisory Action

Continuation of 3a: The proposed amendments to independent claims 27 and 28 attempt to modify the required dopants to other than that which was previously required by the claim and bring newly into consideration additional dopants to be required. Furthermore, the proposed amendments to independent claims 27 and 28 raise issues regarding 112, 2nd paragraph concerns as to the grouping of the dopants required (i.e. is both a transition metal AND chromium, nickel, and alkali metal required?) and further raise the possibility of improper Markush grouping.

Continuation of 3b: The proposed amendments, both to independent claims 27 and 28 and to the specification, raise the issue of new matter as the specification currently requires “at least one species selected from transition metals belonging to groups III to V, chromium, iron, nickel, and alkali metals” and therefore do not require the proposed at least one species of the transition metal AND chromium, iron, nickel, and alkali metal.

Continuation of 3d: The proposed amendment adds new claims 29-31 but does not cancel any claims (it is noted claims 1-26 were already cancelled prior to the proposed amendment).

Continuation of 11:

In the request for reconsideration, the applicant argues on the basis of the limitations as they are proposed to be amended. In light of the fact that the proposed amendments are not being entered, it appears the applicant’s arguments on these issues are moot.

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The applicant next argues regarding the properties of AlH_3 alone; however, the claims require a doped- AlH_3 and therefore these arguments are not commensurate in scope with the claims and are therefore not persuasive.

The applicant next argues that although Pecharsky et al. teaches a “very broad range” of dopant percentages ranging from 0.001-50 mol%, it does not meet the claimed limitation of 0.2-10 mol% *of an amount of the aluminum hybrid* [applicant’s own added emphasis]. However, the applicant simply alleges that Pecharsky et al. does not give the percentage based on the amount of aluminum hybrid; the applicant does not explain how the percentage given by Pecharsky et al. does not meet the claimed percentage and the examiner is of the position that it does meet the claim limitations regardless.

The applicant repeatedly mentions the “hydrogen capacity” of the occluding materials yet it is noted this is not a claimed limitation. In response to applicant's argument that the references fail to show certain features of applicant’s invention, it is noted that the features upon which applicant relies (i.e., hydrogen capacity) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, as the material of the applied art is substantially the same as that which is claimed it would be believed that it would therefore possess the same properties as the material which is claimed inherently.